

REMARKS/ARGUMENTS

Claim 1 has been amended by incorporating Claim 2 therein. Claim 2 has been cancelled. Previously withdrawn Claims 10, 11 and 14 now depend, directly or ultimately, from Claim 1, and thus are now a part of the elected claim set.

The rejection over Reinhardt in view of Cavallotti and de Buzzaccarini as evidenced by Bianchi and is traversed.

The combination of references applied against the claims does not enable the preparation of the presently claimed liquid formulation of imidoalkanepercarboxylic acid in the form of an aqueous dispersion containing high amounts of imidoalkanepercarboxylic acid (7% to 40%) yet showing the, e.g., preferred useful viscosities and dissolution times of the invention dispersions.

As pointed out at specification page 6, lines 22ff, tests performed by the inventors and detailed in the specification show that Applicants' claimed dispersions are "only possible to obtain... if the process is performed according to the process described [in the specification]." Because Claim 2 has now been incorporated into Claim 1, and now points out the specification process by which the claimed dispersions are obtained, patentable subject matter has been defined. That is, Applicants have shown that the process is a feature that provides patentable weight to the claim in that it defines the subject matter and distinguishes it from anything disclosed or suggested by the prior art.

While Applicants recognize the Office position on product-by-process claims as set forth in MPEP 2113, they emphasize that the structure implied by the steps of their claimed process is stated and shown herein (under Declaration) to provide a unique product that is neither disclosed nor suggested in the prior art. Moreover, and to any extent the Office disagrees, it is unequivocally clear that the combination of references does not enable the preparation of dispersions as claimed, for the reasons expressed in the specification. It is

bedrock principle that for a *prima facie* case of obviousness to lie the references must enable one of ordinary skill in the art to make the invention claimed (“A prior art reference provides an enabling disclosure and thus anticipates a claimed invention if the reference describes the claimed invention in sufficient detail to enable a person of ordinary skill in the art to carry out the claimed invention”). See MPEP 2121 (emphasis added).

Only Bianchi, referred to at specification page 1, lines 24ff, describes dispersions related to those claimed herein, but at low amounts of imidoalkanepercarboxylic acid. The present inventors have solved the viscosity and dissolution problem at high imidoalkanepercarboxylic acid loadings by providing an aqueous dispersion as claimed that is useful as a liquid formulation and that has a viscosity of not more than 2000 mPa.sec at 25°C, a dissolution time that is not more than 5 minutes at 40°C or more than 15 minutes at 18°C, and a stable viscosity that does not vary by more than 300 mPa.sec at 40°C for seven days.

Reinhardt’s liquid bleaches, even if meeting certain viscosity levels, necessarily do not meet all the requirements of the present claims, as shown in the specification, and explained above, since the methods used to make them are not those presently claimed. See for Example, Example 1A herein at specification page 14 where a formulation is made using beta crystals of PAP as a starting material – and poor dissolution times are obtained (Table 2 and specification page 15, lines 5-7). This comparison supports Applicants’ statement above regarding that fact that it is only possible to obtain the claimed dispersions if the process according to specification (and claims) is performed, and distinguishes Reinhardt as a pertinent reference.

As none of Cavallotti or de Buzzaccarini add the necessary missing elements of a *prima facie* case, or contribute sufficient information to enable the preparation of the presently claimed dispersions, Applicants respectfully submit that this case is in condition for

Application No. 10/585,659
Reply to Office Action of October 1, 2011

allowance. Withdrawal of the rejection is requested, as is the passage of this case to
Issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Richard L. Treanor
Attorney of Record
Registration No. 36,379

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)

Daniel Farina 45,518